

## REMARKS

Claims 1-45 are pending in the application. Claims 1, 8, 10, 17, 19, 26, 28, and 36 have been previously amended to correct minor informalities in the claims. Claims 38-45 are added. The Specification has been amended to correct the Cross Reference to Related Application section to restore the cross-reference to and incorporation by reference of United States Patent Application Number 09/093,514 which was inadvertently omitted in the amendment filed June 27, 2003. By this amendment, the actual priority date has not been changed. No new matter is added. If the Patent Office feels that a telephone conference would speed prosecution of the Application, the Examiner is kindly invited to contact the undersigned Attorney at (402) 496-0300.

Applicant respectfully requests reconsideration of the Application in view of the foregoing amendments and the following remarks.

### *Claim Rejections – 35 U.S.C. § 103*

Claims 1-37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Goshey et al., U.S. Patent No. 6,205,527 (Goshey) in view of Fletcher et al., U.S. Patent No. 6,009,274 (Fletcher). Applicant respectfully traverses this rejection for the following reasons.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03 citing *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). See also *In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970). Applicant respectfully maintains that the Examiner has failed to establish *prima facie* obviousness of the present invention since neither Goshey nor Fletcher, either alone or in combination, disclose, teach or suggest the use of a restore medium capable of being read by an information handling system, wherein the restore medium includes a program of instructions for initiating a connection with a network storage medium over a network as variously claimed in independent claims 1, 10, 19 and 28.

When applying 35 U.S.C. § 103, the following tenets of patent law must be adhered to: (A) the claimed invention must be considered as a whole; (B) the references

must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) reasonable expectation of success is the standard with which obviousness is determined. *See MPEP § 2141 and Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 220 USPQ 182, 187 n.5 (Fed. Cir. 1986).

Applicant maintains that there exists no reason, suggestion, or motivation from the prior art for modifying the teaching Goshey or Fletcher to provide the restore medium of the presently claimed invention as required by MPEP § 2141. In responding to Applicant's arguments, the Examiner states that the motivation for combining Goshey with Fletcher is "that when installing application on a computer system, it is advantageous to update the software with the newest drivers and updates available, to prevent flaws in the software from causing further damage." Applicant respectfully disagrees. As previously argued, Goshey teaches an intelligent backup system for backing up selected data from a host computer's main storage drive to prevent loss of data or user productivity using a peripheral storage device connected to the computer system, while Fletcher teaches a method and apparatus for automatically updating software components in one or more agents (end system) in a network. Goshey does not discuss initiating a connection with a network storage medium over a network, and thus provides no motivation for such a connection. Fletcher does not address the use of a restore medium and thus provides no motivation for providing a restore medium. Consequently, neither Goshey nor Fletcher may be relied upon to furnish motivation for their combination. As a result, it is believed that the Examiner has impermissibly relied upon Applicant's specification for motivation currently of record for combination these references to provide a restore medium having a set of instructions for initiating connection to a network storage medium for restoring an information handling system. Accordingly, Applicant again submits that a *prima facie* case of obviousness of claims 1-37 has not been established. Withdrawal of the rejections of these claims under 35 U.S.C. § 103 is therefore respectfully requested.

*New Claims 38-45*

With respect to new claims 38-45, neither Goshey nor Fletcher, either alone or in combination, disclose, teach or suggest a method of restoring an information handling system suffering a loss of function, comprising receiving the restore medium in a drive of the information handling system; accessing a restore medium received within the drive; loading a first set of software components from the restore medium, the first set of software components for restoring the information handling system to an operational status; loading a program of instructions from the restore medium for causing the information appliance to initiate a connection with a network storage medium via a network; receiving a second set of software components from the network storage medium via the network connection; and loading the second set of software components for returning the information handling system to a restored state wherein the second set of software components is updated in comparison with software components installed on the information appliance prior to the loss of function as claimed in new independent claim 38. Accordingly, it is submitted that independent claim 38 and its associated dependent claims 39-45 are patentable over the cited references, the references of record and the prior art in general. Allowance of claims 38-45 is therefore requested.

**CONCLUSION**

The application is respectfully submitted to be in condition for allowance of all claims. Accordingly, notification to that effect is earnestly solicited.

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